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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,259	06/11/2001	Michael Schmidt	MERCK-2272	8004

23599 7590 05/12/2006

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/877,259	SCHMIDT ET AL.	
	Examiner	Art Unit	
	Laura L. Stockton, Ph.D.	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18 and 21-28 is/are allowed.
- 6) ☒ Claim(s) 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-28 are pending in the application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on March 24, 2006 has been entered.

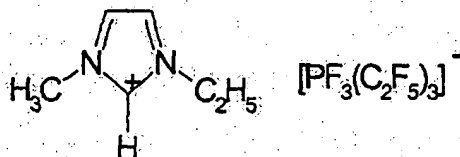
Election/Restrictions

Applicants' election with traverse of Group V and the species of Example 1 on page 21 (reproduced below)

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in the reply filed on December 1, 2004 was acknowledged in a previous Office Action.

Example 1



The requirement was deemed proper and made FINAL in a previous Office Action.

On July 15, 2005, a Petition to the Commissioner under 37 CFR § 1.181 requesting withdrawal of the requirement for restriction of November 15, 2004 was filed.

On September 23, 2005, the Petition Decision granting the withdrawal of the restriction was mailed. The Decision states that the Examiner's restriction requirement of November 15, 2004 will be considered as an election of species requirement (see bottom of page

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2 of the Decision). The Decision also states, "As applicants have elected a species and examination on the species has proceeded with the species currently being rejected over prior art, no further remedy need be considered at this time." See bottom of page 2 and top of page 3 of the Decision.

Therefore, as per the Decision grant of September 23, 2005, subject matter not embraced by the elected species and claims 21-24 and 26-28 were withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions.

As a result of Applicants' current amendments to the claims, the rejection of claims 1-11, 14-18 and 25 under 35 U.S.C. 103(a) as being unpatentable over Koch et al. {U.S. Pat. 5,827,602} and in view of Heider et al. {U.S. Pat. 6,423,454}, Heider et al. {U.S. Pat. 6,548,212} and Hilarius et al. {US 2002/0015883} has

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been overcome. Withdrawn claims 21-24 and 26-28 have now been examined.

Rejections made in the previous Office Action that do not appear below have been overcome by Applicants' amendment to the claims. Therefore, arguments pertaining to these rejections will not be addressed.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in

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such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

No support in the specification or the originally filed claims can be found for the expression "1 $\leq z \leq 2y + 1$ " as found in instant claim 19 and instant claim 20. It is noted that the expression was previously presented in the "Reply" filed July 21, 2003 {Paper No. 8/B} in the then "new" claim 20. Applicants did not state where {page number(s) and line number(s)} support could be found for this expression. Applicants merely stated in the "Remarks" section to see page 4, the examples and the original claims. The instant specification (see page 3, middle of the page) and originally filed claim 1 (page 24, middle of the page) defines the z variable as " $0 \leq z \leq 2y + 1$ ". In all three of the examples, the z variable represents zero. Applicants should specifically point out the support

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for any amendments. See M.P.E.P. §§ 714.02 and 2163.06. Therefore, the claims lack written description as such.

Allowable Subject Matter

The elected species of Example 1, on page 21 of the instant specification, is allowable over the art of record.

Claims 1-18 and 21-28 are allowed over the art of record.

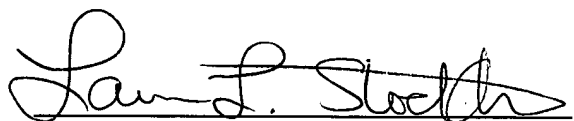
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

May 9, 2006